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2 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

3 Applicant: A.N. Schwartz et al. Attorney Docket No: SWTZ110464
4 Serial No: 08/794,154 Group Art Unit: 3408
5 Filed: February 3, 1997 Examiner: P. Nerbun
6 Title: GOGGLES WITH PLIABLE AND RESILIENT SEALING PAD

7 **PETITION FOR REMAND**

8 Seattle, Washington 98101

9 October 15, 1998

10 TO CHIEF JUDGE, BOARD OF PATENT APPEALS AND INTERFERENCES:

11 Applicants respectfully request that this application be remanded to the Examiner for the
12 purpose of entry of an Amendment canceling Claims 13, 14, 48 and 49 from the application presently
13 on appeal. This petition is based upon the following facts:

14 1. On March 26, 1997, the primary Examiner Peter Nerbun entered a Final Rejection of
15 the claims in the pending application. See Paper No. 15 in Application No. 08/794,154. This Office
16 Action also indicated that Claims 13, 14, 48 and 49 were objected to as being dependent upon a
17 rejected base claim, but would be allowed if rewritten in independent form including all the limitations
18 of the base claim and any of the intervening claim.

19 2. On June 24, 1997, applicants filed an appeal from the Final Rejection in this
20 application.

21 3. On December 30, 1997, the Examiner filed his Answer in this appeal. See Paper
22 No. 20 in application No. 08/794,154. Applicants filed a Reply Brief on March 2, 1998. See Paper
23 No. 24. On September 25, 1998, this application was remanded to the Examiner for "a proper
24 response to Reply Brief." See Paper No. 25.

4. In the meantime, applicants filed a new application (Serial No. 09/069,706) on April 29, 1998. This new application included four new claims which restated Claims 13, 14, 48, and 49 from Application No. 08/794,154 in independent form including all of the limitations of rejected base claim and any intervening claim, as suggested by the Examiner in his March 24, 1997 Office Action.

5. On July 16, 1998, the Examiner mailed an Office Action in Application No. 09/069,706, provisionally rejecting the four new claims under 35 U.S.C. § 101 as claiming the same invention as Claims 13, 14, 48 and 49 of the co-pending Application No. 08/794,154. See Exhibit A hereto.

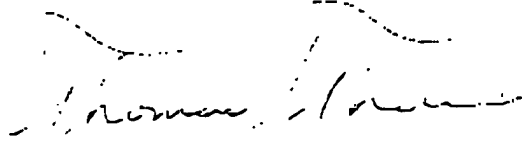
6. Applicants respectfully request that Application Serial No. 08/794,154 be remanded to the Examiner for purpose of entry of an amendment canceling Claims 13, 14, 48 and 49 from that application. See Exhibit B hereto.

Additional Fee Charges or Credit for Overpayment

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.18 which may be required during the entire pendency of the application, or credit any overpayment, to Deposit Account No. 03-1740. This authorization also hereby includes a request for any extensions of time of the appropriate length required upon the filing of any reply during the entire prosecution of this application. A copy of this sheet is enclosed.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON & KINDNESS^{PL.L.C.}


Thomas D. Theisen
Registration No. 35,713
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1 I hereby certify that this correspondence is transmitted via facsimile addressed to: Facsimile No.
2 703,308,7952. Attn: Craig Kleinberg, U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.
3 Washington, D.C. 20231. on October 15, 1998.

4 Date: October 15, 1998

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Office Action SummaryApplication No.
09/069,706Applicant(s)
Schwartz et alExaminer
Peter NerbunGroup Art Unit
3741☐ Responsive to communication(s) filed on _____☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 11-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.☒ Claim(s) 11-14 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152**EXHIBIT A**

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Art Unit: 3408

Claims 11, 12, 13, and 14 of this application conflict with claims 13, 14, 48, and 49 of Application No. 08/794,154. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 11, 12, 13, and 14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13, 14, 48, and 49 of copending Application No. 08/794,154. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The patent to Hisataka is cited to disclose an article of headwear having face pad layers 12a, 12b, Fig. 2 which offer differing levels of resistance to deformation so that the inner layer

Serial Number: 09/069,706

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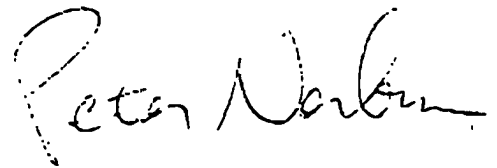
Art Unit: 3408

12b is soft to provide comfort in contacting the face whereas the outer layer 12a is relatively hard to provide shock resistance.

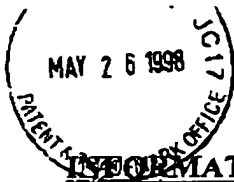
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Nerbun, whose telephone number is (703)-308-0955. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner also can be reached on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-0861.

Peter Nerbun
July 1, 1998



Peter Nerbun
Primary Examiner



**INFORMATION CITED BY APPLICANTS THAT MAY BE MATERIAL
TO THE PROSECUTION OF THE SUBJECT APPLICATION**

Applicants: A.N. Schwartz et al. Attorney Docket No: SWTZ112205
 Serial No: 09/069,706 Group Unit: 3408
 Filed: April 29, 1998 Examiner: P. Nerbun
 Title: GOGGLES WITH PLIABLE AND RESILIENT SEALING PAD

U.S. PATENT DOCUMENTS

*Examiner Initial	ID	Document No.	Date	Name
<u>PW</u>	U1	3,725,953	04/10/1973	Johnson et al.
<u>PW</u>	U2	4,369,284	01/18/1983	Chen
<u>PW</u>	U3	4,665,570	05/19/1987	Davis
<u>PW</u>	U4	4,707,863	11/24/1987	McNeal
<u>PW</u>	U5	5,093,940	03/10/1992	Nishiyama
<u>PW</u>	U6	5,331,691	07/26/1994	Runckel
<u>PW</u>	U7	5,334,646	08/02/1994	Chen
<u>PW</u>	U8	5,647,357	07/15/1997	Barnett et al.

FOREIGN PATENT DOCUMENTS

*Examiner Initial	ID	Document No.	Publication Date	Country	Translation Provided
					Yes No

None

///
///

Peter Nerbun
EXAMINER

07-01-98
DATE CONSIDERED

OTHER INFORMATION(Including Author, Title, Date, Pertinent Pages, Etc.)

*Examiner Initial	ID	Document Information
<u>PN</u>	O1	Barracuda The Best Swim Goggles packaging
<u>PN</u>	O2	Parker Laboratories, Inc., Aquaflex® Ultrasound Gel Pad sales literature, 1991
<u>PN</u>	O3	3M Health Care sales brochure, <i>Just plain talk about the many uses of Tegaderm™ transparent dressing</i> , 1990

Examiner

PN Werbur

Date Considered

07-01-98

*Examiner: Initial if reference considered, whether or not citation is in conformance with M.P.E.P. § 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicants.

TDT:skg

Notice of References CitedApplication No.
09/069,706Applicant:
Schwartz et alExaminer
Peter NerbunGroup Art Unit
3741

Page 1 of 1

U.S. PATENT DOCUMENTS

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,390,373	2-1995	Flory	2	430
B	4,446,576	5-1984	Hisataka	2	9X
C					
D					
E					
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H					
I					
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FOREIGN PATENT DOCUMENTS

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N						
O						
P						
Q						
R						
S						
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NON-PATENT DOCUMENTS

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
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X		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: A.N. Schwartz et al.

Attorney Docket No. SWTZ112205

Serial No.: 09/069,706

Group Art Unit: 3408

Filed: April 29, 1998

Examiner: P. Nerbun

Title: GOGGLES WITH PLIABLE AND RESILIENT SEALING PAD

RESPONSE TO AN OFFICE ACTION

Seattle, Washington 98101

October 15, 1998

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

The Examiner's Office Action mailed July 16, 1998 provisionally rejected Claims 11-14 under 35 U.S.C. § 101 as claiming the same invention as that of Claims 13, 14, 48 and 49 of Application No. 08/794,154, now on appeal. Applicants respectfully thank the Examiner for the courtesy extended in a telephone interview Monday, October 12, 1998, regarding an appropriate response to the Office Action.

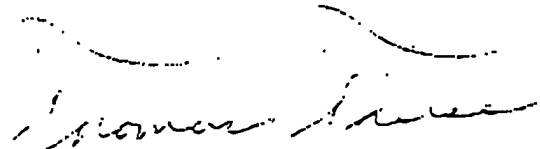
Pursuant to the telephone interview on October 12, applicants have filed the attached petition requesting the Board of Patent Appeals and Interferences to remand the co-pending Application No. 08/794,154 to the Examiner for the purpose of entering an amendment canceling Claims 13, 14, 48 and 49 from that application. Applicants further request the Examiner suspend prosecution of the present application, pending the Board's ruling on the above-described petition. Applicants finally request that upon remand, the Examiner enter an Examiner's amendment in Application No. 08/794,154 canceling Claims 13, 14, 48 and 49, and applicants hereby consent to the entry of such Examiner's amendment.

Again, applicants thank the Examiner for the courtesy extended in resolving this matter.

EXHIBIT B

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON & KINDNESS^{PLLC}


Thomas D. Theisen
Registration No. 35,713
Direct Dial (206) 224-0721

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on October 15, 1998

Date: October 15, 1998

TDT:jk

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